

1 REMARKS

2 Status of the Claims

3 Claims 1-45 are pending in the application, Claims 1, 2, 5, 7, 9, 12, 16-20, 23, 26, 28-32, 35, 38, 39, 42,
4 44, and 45 having been amended to more clearly define what is considered to be novel. Claim 36 is amended to
5 correct a typographical error.

6 Claim Objections

7 The Examiner has renewed the objection to Claims 14 and 15 as being of improper dependent form for
8 failing to further limit the subject matter of a previous claim. The Examiner has again indicated that applicants
9 should cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims
10 in independent form. The Examiner asserts that the infringement test for determining a proper dependent claim
11 as per the MPEP 608.01 (n), Section 3, states that such a claim cannot conceivably be infringed by anything that
12 would not also infringe the claim it references. Applicants respectfully, but strongly, disagree with the
13 Examiner's conclusions for the following reasons.

14 As was established by the Examiner in the last Office Action, Claims 14-15 properly depend from
15 independent method Claim 1. Applicants assert that dependent Claims 14 and 15, properly further limit the
16 patentable subject matter of Claim 1 because they recite that a computer readable medium is employed for
17 storing computer-executable instructions that perform one or more steps of Claim 1. As was pointed out to the
18 Examiner in a prior Office Action response, each of Claims 14 and 15 further limits Claim 1 by providing that
19 computer-executable instructions for performing one or more steps of the method are stored on a computer
20 readable medium. As was also previously pointed out to the Examiner, the same result could be achieved by
21 drafting Claim 14 to read, for example: "The method of Claim 1 further comprising the step of providing
22 computer-executable instructions stored on a computer readable medium for carrying out steps (a), (c), and (d),"
23 but that form of claiming is unnecessary, since the current form is an acceptable form of dependent claiming that
24 has been allowed and issued in numerous patents. Clearly, Claim 1 is further limited by ANY step of the method
25 being further stored to a medium as machine readable instructions. Accordingly, the Examiner is respectfully
26 requested to withdraw the objection of Claims 14 and 15. The Examiner is also respectfully encouraged to
27 review this matter with a Supervising Patent Examiner, or the Office of the Solicitor, in order to more clearly
28 understand that such a recitation does in fact further limit the scope of Claim 1, since all of the limitations of
29 Claim 1 are incorporated into any claim that depends upon Claim 1, by definition.

1 Claims Rejected under 35 U.S.C. § 102(e)

2 The Examiner has renewed a rejection of Claims 1-2, 5-7, and 13-15 as being anticipated by Allen et al.
3 (U.S. Patent No. 6,026,410 hereinafter referred to as "Allen"). The Examiner asserts that Allen describes each
4 element of applicants' claim recitation. Applicants respectfully disagree for the reasons noted below.

5 In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the
6 following discussion focuses on independent Claims 1, 16, 28, 39, and 44. The patentability of each dependent
7 claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the
8 differences between the cited art and each dependent claim should not be considered as an admission that
9 applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the cited
10 references. Similarly, applicants' decision not to discuss differences between the prior art and every claim
11 element, or every comment made by the Examiner, should not be considered as an admission that applicants
12 concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that
13 all of the dependent claims patentably distinguish over the references cited. However, a specific traverse of the
14 rejection of each dependent claim is not required, since dependent claims are patentable for at least the same
15 reasons as the independent claims from which the dependent claims ultimately depend. Support for the
16 amendments to the claims is provided by the specification at least at page 7, lines 4-5, page 11, lines 15 to 16,
17 page 22, lines 7-9, and 17-19, and FIGURE 5, element 330.

18 Independent Claim 1

19 Applicants' have amended Claim 1 to further clarify the distinguishing features of what is considered
20 novel over the teachings of Allen. Specifically, Allen does not disclose or suggest the recitation of a "**tag**
21 **action**," such as now recited in step (b), "...each of the plurality of tags having a corresponding *tag action*
22 associated with it," or as recited in step (d), "automatically carrying out the *tag action* associated with said at least
23 one tag, wherein the *tag action* exhibits at least one behavior in the document that is based on at least one of a
24 template and a schema associated with both the tag and the document." Applicants define a *tag action* at page
25 11, lines 15 to 16 of the instant application as follows: "**Tag Action** - a component which is called by the
26 productivity application if the user hovers over a recognized tag." Allen does not disclose or suggest a "tag
27 action" or any equivalent to what applicants have defined in their specification, and as recited by applicants
28 Claim 1. Furthermore, Allen does not disclose or suggest that a "tag action exhibits at least one behavior in the
29 document that is based on at least one of a template and a schema associated with both the tag and the
30 document." In fact, neither of the words "template" or "schema" occur anywhere in the disclosure of Allen.

1 Additionally, the functionality embodied in the recitation of Claim 1 is neither disclosed nor suggested anywhere
2 in the disclosure of Allen. For at least these reasons, applicants assert that Allen does not anticipate applicants'
3 Claim 1 or render it obvious.

4 Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Allen should be
5 withdrawn, for the reasons given above, since Allen does not teach or suggest all of the recitation of independent
6 Claim 1.

7 Claims 2, 5-7, and 13-15 depend from independent Claim 1. Because dependent claims inherently
8 include all of the steps or elements of the independent claim from which the dependent claims ultimately depend,
9 dependent Claims 2, 5-7, and 13-15 are patentable for at least the same reasons discussed above with regard to
10 independent Claim 1. Accordingly, the rejection of dependent Claims 2, 5-7, and 13-15 under
11 35 U.S.C. § 102(e) over Allen should be withdrawn.

12 Claims Rejected under 35 U.S.C. § 103(a)

13 The Examiner has rejected Claims 3-4 and 10 under 35 U.S.C. § 103(a) as being unpatentable over
14 Allen and further in view of Goldberg et al. (U.S. Patent No. 5,651,107, hereinafter referred to as "Goldberg").

15 In addition, the Examiner has rejected Claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable
16 over Allen and further in view of Budzinski et al. (U.S. Patent No. 5,715,468, hereinafter referred to as
17 "Budzinski").

18 Claims 11-12, 39-41, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen and
19 further in view of Ho et al. (U.S. Patent No. 5,836,771, hereinafter referred to as "Ho").

20 Also, the Examiner has rejected Claims 16-18, 20-21, 23-24, 27-30, 32-33, and 35-36 as being
21 unpatentable over Allen and further in view of Kanaegami et al. (U.S. Patent No. 5,297,039, hereinafter referred
22 to as "Kanaegami").

23 The Examiner has rejected Claims 22, 25, 34, and 37 as being unpatentable over Allen in view of
24 Kanaegami, and Budzinski.

25 The Examiner has rejected Claim 42 as being unpatentable over Allen in view of Ho and further in view
26 of Goldberg.

27 Claim 44 is rejected as being unpatentable over Goldberg, in view of Carter et al. (U.S. Patent
28 No. 6,108,619, hereinafter referred to as "Carter").

1 The Examiner has rejected Claim 45 as being unpatentable over Goldberg, in view of Carter and further
2 in view of Fukao et al. (U.S. Patent No. 5,323,311, hereinafter referred to as "Fukao"). Applicants respectfully
3 disagree with these rejections for the reasons noted below.

4 Independent Claim 16

5 Independent Claim 16, as amended, now recites "automatically causing a tag action associated with said
6 instance to be implemented in the document based on at least one of a template and a schema associated with
7 both the instance and the document." However, as explained above with regard to the traverse of the rejection of
8 Claim 1, Allen does not disclose or suggest each of the requirements recited in Claim 16. Furthermore,
9 Kanaegami fails to cure the deficiencies of Allen, since Kanaegami also fails to teach or disclose any element
10 corresponding to a tag action as defined by applicants' specification. Accordingly, the rejection of independent
11 Claim 16 under 35 U.S.C. § 103(a) over Allen and further in view of Kanaegami should be withdrawn, for the
12 reasons given above, since Allen and Kanaegami do not teach or suggest all of the recited steps of independent
13 Claim 16.

14 Claims 17-27 ultimately depend from independent Claim 16. Because dependent claims inherently
15 include all of the steps or elements of the independent claim from which the dependent claims ultimately depend,
16 dependent Claims 17-27 are patentable for at least the same reasons discussed above with regard to independent
17 Claim 16. Accordingly, the rejection of dependent Claims 17-27 under 35 U.S.C. § 103(a) over Allen and
18 further in view of Kanaegami should be withdrawn.

19 Independent Claim 28

20 Independent Claim 28, as amended, now recites "automatically causing an associated tag action to be
21 implemented in the document based on at least one of a template and a schema associated with both the instance
22 and the document." Therefore, for the reasons discussed above with reference to Claims 1 and 16, neither Allen
23 nor Kanaegami teaches or suggests "automatically causing an associated tag action to be implemented in the
24 document based on at least one of a template and a schema associated with both the instance and the document."
25 Accordingly, the rejection of independent Claim 28 under 35 U.S.C. § 103(a) over Allen and further in view of
26 Kanaegami should be withdrawn, for the reasons given above, since Allen and Kanaegami, read separately or
27 together, do not disclose or suggest all of the recited steps of independent Claim 28.

28 Claims 29-38 ultimately depend from independent Claim 28. Because dependent claims inherently
29 include all of the steps or elements of the independent claim from which the dependent claims ultimately depend,
30 dependent Claims 29-38 are patentable for at least the same reasons discussed above with regard to independent

1 Claim 28. Accordingly, the rejection of dependent Claims 29-38 under 35 U.S.C. § 103(a) over Allen and
2 further in view of Kanaegami should be withdrawn.

3 Independent Claim 39

4 Independent Claim 39, as amended, now recites "providing the dictionary, and the tags and the tag
5 actions associated with the tags in respect to the template to a user who is working on the document in the
6 productivity software application, to enable the text entered by the user to be recognized as corresponding to one
7 of the tags, so that the tag action associated with said one of the tags is carried out in the document based on the
8 template, the template being associated with both the document and said one of the tags." For the reasons
9 discussed above in connection with the traverse of the rejection of independent Claim 1, Allen does not teach or
10 suggest all of the elements of this claim. Furthermore, step (c) of Claim 39 has been amended to recite "storing
11 the tags and *tag* actions associated with the tags for the template in a catalog that is maintained at a site centrally
12 accessible over a network by each of a plurality of users." Neither Allen nor any portion of Ho teaches or
13 suggests a catalog of tags and *tag actions* being maintained at a site centrally accessible over a network, by each
14 of a plurality of users. Accordingly, the rejection of independent Claim 39 under 35 U.S.C. § 103(a) over Allen
15 and further in view of Ho should be withdrawn, for the reasons given above, since Allen and Ho do not teach or
16 suggest all of the recited steps of independent Claim 39.

17 Claims 40-43 ultimately depend from independent Claim 39. Because dependent claims inherently
18 include all of the steps or elements of the independent claim from which the dependent claims ultimately depend,
19 dependent Claims 40-43 are patentable for at least the same reasons discussed above with regard to independent
20 Claim 39. Accordingly, the rejection of dependent Claims 40-43 under 35 U.S.C. § 103(a) over Allen and
21 further in view of Ho should be withdrawn.

22 Independent Claim 44

23 Step (a) of Claim 44, as amended, now recites "a memory in which machine instructions and data are
24 stored, said data including a plurality of tags and *tag actions* associated with the tags in regard to a template on
25 which the document is based." Additionally, step (c)(i) further recites "enabling any of a plurality of remote
26 computing devices to access and download the tags and *tag actions* associated with the tags over a network for
27 use in carrying out the *tag action* associated with any tag that corresponds to text entered in the document."
28 (Emphasis added.)

1 Accordingly, the rejection of independent Claim 44 under 35 U.S.C. § 103(a) over Goldberg and further
2 in view of Carter should be withdrawn, for the reasons discussed above with regard to traversing the rejection of
3 Claim 1, since Goldberg and Carter do not teach or suggest all of the recitation of independent Claim 44.

4 Claim 45 ultimately depends from independent Claim 44. Because dependent claims inherently include
5 all of the steps or elements of the independent claim from which the dependent claims ultimately depend,
6 dependent Claim 45 is patentable for at least the same reasons discussed above with regard to independent
7 Claim 44. Accordingly, the rejection of dependent Claim 45 under 35 U.S.C. § 103(a) over Goldberg in view of
8 Carter and in view of Fukao should be withdrawn.

9 Discussion of the Rejection of Dependent Claims 3-4, and 8-12

10 Claims 3-4 and 8-12 ultimately depend from independent Claim 1. Because dependent claims
11 inherently include all of the steps or elements of the independent claim from which the dependent claims
12 ultimately depend, dependent Claims 3-4 and 8-12 are patentable for at least the same reasons discussed above
13 with regard to independent Claim 1. Accordingly, the rejection of dependent Claims 3, 4 and 10; 8 and 9; and 11
14 and 12 under 35 U.S.C. § 103(a) over Allen and in view of Goldberg; and Allen in view of Budzinski; and Allen
15 in view of Ho, respectively, should be withdrawn.

16 In view of the Remarks set forth above, it will be apparent that the claims in this application define a
17 novel and non-obvious advance over the prior art, and that the application is in condition for allowance and
18 should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to
19 telephone applicants' attorney at the number listed below.

20 Respectfully submitted,

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